

Application No. 10/001,708

REMARKS

Claims 1-13 and 15-20 are pending. By this Amendment, claims 2, 3, 6, 9 and 10 are cancelled, and claims 1, 4, 5, 7, 8, 11, 13, 15, 16, and 20 are amended. No new matter has been added by way of these amendments.

Claim Rejections Under 35 U.S.C. § 112

Claims 1, 6, 11, 13, 15, 16 and 20 stand rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which is not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. While Applicant respectfully traverses this rejection, claims 1, 11, 13, 15, 16 and 20 have been amended to recite a "fixed" blade, as the blade is not rotatable. Claim 6 has been canceled.

As a result, Applicant respectfully requests withdrawal of the rejection of claims 1, 11, 13, 15, 16 and 20 under 35 U.S.C. § 112, first paragraph.

Claim Rejections Under 35 U.S.C. § 102

Claims 11-13 stand rejected under 35 U.S.C. 102(b) as being anticipated by Hochfeld et al. (U.S. Patent No. D308,811).¹ Applicant respectfully traverses this rejection as Hochfeld does not teach or suggest the tubing cutter of amended independent claims 11 and 13.

¹ While the rejection references Patent No. "2,254,199," it appears from the figure included in the office action that the Examiner is relying upon the D308,811 design patent to Hochfeld.

Application No. 10/001,708

Hochfeld does not teach or suggest, in combination with the other recited limitations of independent claim 11, a C-shaped grasping portion having an opening and "a bottom portion positionally opposite the opening," or a fixed blade that "extends into and across the bottom portion of the grasping portion." Hochfeld further fails to teach or suggest a "tube receiving region having a width generally less than the diameter of the plastic tubing," "to forcefully receive and deform the tubing within the tube receiving region." Instead, the Hochfeld opener provides a blade adjacent/proximate the opening, and relies upon bending of the opener itself at the living hinge or integrated groove to grasp the coin rolls, rather than structure that facilitates the deformation of inserted plastic tubing for engagement as is required in amended claim 11.

With regard to independent claim 13, Hochfeld fails to teach or suggest, in combination with the other recited limitations, a "fixed blade having an exposed chordal portion extending into the grasping portion across a bottom portion opposite the engagement opening."

As a result of the foregoing reasoning, Applicant respectfully requests withdrawal the rejections of claims 11 and 13, and all claims depending therefrom, under 35 U.S.C. § 102.

Claim Rejections Under 35 U.S.C. § 103

Claims 1-4, 6-10, and 15-20 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Hochfeld in view of Baltuch (U.S. Patent No. 2,254,199), or Mancini (Des. 362,168). Applicant respectfully traverses this rejection as Hochfeld, Baltuch and Mancini fail to teach or suggest, alone or in combination, the tubing cutter of amended independent claims 1, 15, 16 or 20.

Application No. 10/001,708

Neither Hochfeld or Baltuch, nor Hochfeld or Mancini, alone or in combination, teach, suggest or provide the motivation to teach the tubing cutter of independent claim 1 having a body defining "symmetrical side portions having alignably opposed arcuate gripping depressions", a C-shaped grasping portion with an opening and "a bottom portion directly opposite the opening," or a "fixed razor blade" that is "secured between the front and back pieces of the body such that a chordal portion of the blade extends into the grasping portion across the bottom portion." Further, the cited references do not teach or suggest a "tube receiving portion having a width generally less than the diameter of the plastic tubing" such that the C-shaped grasping portion receives the plastic tubing with snap engagement, "deforming the plastic tubing within the grasping portion and securely retaining the plastic tubing" therein. Instead, the Hochfeld opener is asymmetrical, and includes a blade proximate or adjacent the opening rather than opposite the opening. Further, Hochfeld only teaches an integrated groove or living hinge in the opener itself to adjust for receiving coin rolls, rather than structure that facilitates the deformation of inserted plastic tubing for engagement as required by amended claim 1.

With respect to independent claim 15, neither Hochfeld or Baltuch, nor Hochfeld or Baltuch, alone or in combination, teach, suggest or provide the motivation to teach a C-shaped grasping portion an opening and "a bottom portion opposite the opening" or a fixed blade "secured between the front and back pieces of the body within a blade recessed portion such that a chordal portion of the blade extends into the grasping portion and across the bottom portion."

With respect to independent claim 16, neither Hochfeld or Baltuch, nor Hochfeld or Baltuch, alone or in combination, teach, suggest or provide the motivation to teach a fixed

Application No. 10/001,708

cutter blade "sandwiched between the two body pieces in said recess," or a C-shaped grasping portion defining an opening "and a bottom blade portion distal and opposite the opening" with the "the chordal portion of the cutter blade positioned to extend across the bottom blade portion."

With respect to independent claim 20, neither Hochfeld or Baltuch, nor Hochfeld or Baltuch, alone or in combination, teach, suggest or provide the motivation to teach a fixed cutter blade "sandwiched between the two body pieces in said recess," or a C-shaped grasping portion defining an opening and "a bottom portion directly opposite the opening" with "the chordal portion of the cutter blade positioned to extend across the bottom portion."

Each of the pending independent claims include at least, in addition to other recited limitations, the bottom portion of the grasping portion being opposite the opening, and the chordal portion of the fixed blade extending across said bottom portion. The coin roll opener of Hochfeld teaches away from positioning the blade opposite the opening as such would prohibit the integrated groove or living hinge proximate the bottom of the device from expanding and contracting during use to receive coin rolls. *See* Hochfeld, Figs. 1 and 3; MPEP § 2141.02. In addition, it is respectfully submitted that one of ordinary skill in the art of the present invention would not consider or look to the non-analogous art of coin roll opening as it is not pertinent, nor would it have commended itself to the inventors' attention for the cutting of dual containment tubing. *See* MPEP § 2141.01(a).

Claim 5, stands rejected under 35 U.S.C. 103(a) as being unpatentable over Hochfeld in view of Baltuch or Mancini, as applied to claim 1, and in further view of Janky (U.S.

Application No. 10/001,708

Patent No. 5,815,866). Applicant respectfully asserts that claim 5 is allowable over the cited references, alone and in combination, as it depends from amended independent claim 1.

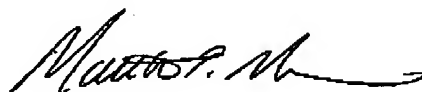
As a result of the foregoing reasoning, Applicant respectfully requests withdrawal of the rejections of claims 1, 15, 16 and 20, and all claims depending therefrom, under 35 U.S.C. § 103(a).

CONCLUSION

In view of the foregoing, it is submitted that this application is in condition for allowance. Favorable consideration and prompt allowance of the application are respectfully requested.

The Examiner is invited to telephone the undersigned if the Examiner believes it would be useful to advance prosecution.

Respectfully submitted,



Matthew T. Macari
Registration No. 50,291

Customer No. 24113
Patterson, Thuent, Skaar & Christensen, P.A.
4800 IDS Center
80 South 8th Street
Minneapolis, Minnesota 55402-2100
Telephone: (612) 349-5759